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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,989	09/26/2001	Roland N. Walker	10414.4	2969

21999 7590 06/25/2003

KIRTON AND MCCONKIE
1800 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
P O BOX 45120
SALT LAKE CITY, UT 84145-0120

EXAMINER

BAHTA, ABRAHAM

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 06/25/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,989

Applicant(s)

WALKER, ROLAND N.

Examiner

Abraham Bahta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 11-15 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-30 are pending in this application. Claims 1-10 and 16-20 are withdrawn from further consideration as being drawn to a non-elected invention.

The amendment filed 04/04/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the limitation such that "the image has been machine printed wherein the flower is a natural configuration" as recited in the claims is new matter. There is no previous mention of "machine printed" and the flower being in "a natural configuration".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 13-15, 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al (USP 6,172,328).

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Jones teaches an organic product such as a leaf/ flower petals which may be in a natural configuration (see Fig. 1) in which the organic product may be marked/etched with a device/laser/galvanometer. The marking may be a message of greeting, expression, identification, information, communication, inscription and advertisement. See col. 1, lines 54-65; col. 3, lines 21-49 and col. 4, lines 21-27.

Regarding the limitation such that the “image being printed”, Webster’s II New Riverside University Dictionary defines the word “print” as a device or implement as a stamp, die, or seal, for pressing markings on or into a surface. Thus, the limitation of the claim is met by the disclosure.

Regarding claim 15, patentability of product-by-process claims are based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones ‘328.

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As discussed above, Jones teaches applicant's claimed invention except fails to mention the flower is a rose; however, it is the Examiner position that since Jones indicates that a flower petal or leaves may be marked with a device the skilled artisan would find it obvious to use a rose or a petal because a petal is the colored segment of an outer envelope of a flower composed of fused or separate petals and a rose is a flower according to Webster's II New Riverside University Dictionary. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide an image or a mark on a rose or a petal because petals, flowers, leaves or roses may be used interchangeably.

Claim Rejections - 35 USC § 103

Claim 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones '328.

As discussed above, Jones teaches applicant's claimed invention except fails to mention the petal being detached from the flower; however, Jones teaches a flower/petal may be marked/etched with a device. It would have been obvious to one of ordinary skill in the art to mark/print only the petal portion of a flower so that only the petal may be attached to a card or other flower group for aesthetic reasons.

Regarding claim 25, Jones teaches applicant's claimed invention except fails to mention the flower is a rose; however, it is the Examiner position that since Jones indicates that a flower petal or leaves may be marked with a device the skilled artisan would find it obvious to use a rose or a petal because a petal is the colored segment of an outer envelope of a flower composed of

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fused or separate petals and a rose is a flower according to Webster's Li New Riverside University Dictionary. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide an image or a mark on a rose or a petal because petals, flowers, leaves or roses may be used interchangeably.

Regarding claims 26, 28-30, Jones teaches the ornament design or marking formed on the flower/petal may be a message, greeting, expression, identification, information, communication, inscription, advertisement, bar code, inventory marking price information or business message. See col. 3, lines 21-38.

Regarding claim 27, patentability of product-by-process claims are based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Claim Rejections - 35 USC § 103

Claims 11-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skonecki (USP 5,305,550) in view of Jones '328.

Skonecki teaches an organic product such as fresh natural flower, such as a rose in a natural configuration in which the product is provided with a personalized message or drawing inscribed on one of its petals. See col. 1, lines 24-38.

The reference does not require machine print. Jones '328 teaches an organic product such as a flower/petal/leaf which may be marked/etched with a device.

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to mark or print with a machine as taught by Jones in order to mass produce the product.

Regarding claim 14, 21-23, since Skonecki teaches the flower may be provided with a personalized message, it would have been obvious to one of ordinary skill in the art at the time of the invention to mark/print/etch the desired image or personalized message as a matter of obvious design choice.

Regarding claim 15, patentability of product-by-process claims are based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Claim Rejections - 35 USC § 103

Claims 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skonecki '550 in view of Jones '328.

Skonecki teaches an organic product such as fresh natural flower, such as a rose in a natural configuration in which the product is provided with a personalized message or drawing inscribed on one of its petals. See col. 1, lines 24-38.

The reference does not require machine print. Jones '328 teaches an organic product such as a flower/petal/leaf which may be marked/etched with a device.

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to mark or print with a machine as taught by Jones in order to mass produce the product.

As to the limitation such that the petal is detached from the flower; it would have been obvious to one of ordinary skill in the art to mark/print only the petal portion of a flower so that only the petal may be attached to a card or other flower group for aesthetic reasons.

Regarding claim 26, 28-30, since Skonecki teaches the flower may be provided with a personalized message, it would have been obvious to one of ordinary skill in the art at the time of the invention to mark/print/etch the desired image or personalized message as a matter of obvious design choice.

Regarding claim 27, patentability of product-by-process claims are based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Response to applicant's arguments


Applicant's arguments with respect to claims 11-15 and 21-30 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication should be directed to Abraham Bahta at telephone number (703) 308-4412. The Examiner can normally be reached Monday-Friday from 11:30 AM -8:00 PM (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor Deborah, Jones, can be reached on (703) 308-3822.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


DEBORAH JONES
SUPERVISORY PATENT EXAMINER


A. Bahta

06/18/03